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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,595	07/03/2003	Nicholas Edward Kreusser	NICK1	7255
35938	7590	08/11/2004	EXAMINER	
BIOTECHNOLOGY LAW GROUP 658 MARSOLAN AVENUE SOLANA BEACH, CA 92075			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 08/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,595

Applicant(s)

KREUSSER ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>03 July 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features of the Hit-A-Way™ must be shown and identified or the feature(s) canceled from the claim(s). No new matter should be entered. It should be noted since the claimed features do not have corresponding description in the specification (see the Hit-A-Way™ as shown in figure 2) it is unclear what features applicant is actually claiming.

Additionally, the drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, an internal removable weight; carrying case; and instruction video must be shown and identified or the feature(s) canceled from the claim(s). No new matter should be entered.

Additionally, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference character(s) mentioned in the description: bat 30.

Additionally the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: The features of the Hit-A-Way™ as shown in figure 2. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement

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Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. In the instant case "described and claimed".

3. The disclosure is objected to because of the following informalities: on page 3, lines 11-13, the paragraph is incomplete since a period has not been included after "described in".

Appropriate correction is required for the above objection.

4. The use of the trademark VELCRO has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

5. Claim 1 is objected to because of the following informalities: on line 16, it is unclear what is meant by "said between said". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is important to recognize that a Trademark or Trade Name is used to identify a source of goods, and not the good themselves. Thus a Trademark or Trade Name does not identify or describe the goods associated with the Trademark or Trade Name. See definitions of Trademark and Trade Name in MPEP 608.01(v). A Trademark or Trade Name used in a claim as a limitation to identify or describe a particular material or product does not comply with the requirements of 35 USC 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the Trademark or Trade Name cannot be used properly to identify any particular material or product. In fact, the value of the Trademark or Trade Name would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a Trademark or Trade Name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the Trademark or Trade Name. If the Trademark or Trade Name appears in a claim and is not intended as a limitation in the claim, then the question

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of why it is in the claim arises and whether or not its presence causes confusion as to the scope of the claimed subject matter. In the instant case Hit-A-Way™ as claimed in claim 6.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minniear (6,514,161).

Regarding claims 1-3, Minniear discloses the claimed invention and shows the practice device can be used in combination with a striking instrument such as a racket, a bat stick, or one's hand, but Minniear does not disclose expressly that the practice device can also be used with a weighted bat. the use of weighted bats is well known in the practice and training art and it is customarily used in such instances as in 1) warm-up prior to batting; 2) improving batting ability of individual batters; 3) improving hand-eye coordination of batters etc. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a weighted bat, because Applicant has not disclosed that using a weighted bat, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the bat taught by Minniear or the claimed weighted bat because both bats perform the same function of striking the tethered ball. Therefore, it would have been an obvious matter of design choice to modify Minniear to obtain the invention as specified in the

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claims. The Examiner takes Official Notice that it is well known to provide instructions for use and an optional of carrying case for storing and carrying the weighted components.

Alternatively:

10. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minniear (6,514,161) in view of Hamilton (3,521,883).

Regarding claims 1-3, Minniear discloses the claimed invention and shows the practice device can be used in combination with a striking instrument such as a racket, a bat stick, or one's hand, but Minniear does not disclose expressly that the practice device can also be used with weighted bats. Hamilton shows a weighted bat, wherein the principal object of the invention is to provide a novel and improved method of weighting a baseball bat with a view towards developing the wrist and forearm and the snap of the wrist of the batter. A further object of the invention is to adapt a baseball bat to develop the batting action of the batter by weighting a the outer portion of the baseball bat with a removable weight. Another object of the invention is to provide a weight with which a baseball bat may be weighted in such a manner as to develop the forearms and wrist and snap of the wrist of the batter, by placing the weight around a portion of the baseball bat, the weight being held in place by the curvature of the baseball bat and through the action of frictional resistance. Still another object of the invention is to provide a means of non-destructively weighting a regulation baseball bat in such a manner as to enable a batter to develop muscular coordination and strength and to perfect a swing-snap-action, and feel for the baseball bat. In view of Hamilton, it would have been obvious to utilize the practice device of Minniear with a weighted bat, the motivation being to improve the batting skills of a batter while providing a stationary device that requires minimum space. The examiner takes Official Notice

that it is well known to provide instructions for use and an optional of carrying case for storing and carrying the weighted components. It should be noted that a mere addition of a carrying case and an instruction booklet to the existing and well known methods of training and practice device of the prior art, does not make the claims distinguishable over the prior art of record.

Regarding claim 4, Minniear as modified above, does not disclose expressly the use of video instructions. It is well known to include various means of instructions for the convenience of the end user. The use of video instructions is prevalent in the sports art, and it would have been obvious to provide the same for the practice device of Minniear.

Regarding claim 5, with regards to the carrying case being formed of cloth and plastic. The Examiner takes Official Notice that it is well known to utilize any well-known material including cloth and/or plastic to form a carrying case, and it would have been obvious to provide the same for the modified device of Minniear.

Regarding claims 6-8, during normal use and operation of the modified Minniear device, the method steps set forth by applicant in the claim are obviously provided. With regards to the bat being provided with an internal removable weight, inasmuch as applicant has shown and described the weight being positioned internally, the modified device of Minniear also shows the weight to be positioned internally.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson; Taylor; Weisz et al; O'Leary; Bales; Matulck et al.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
6 August 2004


MITRA ARYANPOUR
PATENT EXAMINER